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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,448	04/07/2001	Eric Schneider		4744

24226 7590 10/12/2004
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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,448

Applicant(s)

SCHNEIDER, ERIC

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections under 35 USC § 112 have been withdrawn due to applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quatse et al. (US 5,991,368) in view of Trell (US 6,393,117) and further in view of Kamel et al. (US 5,937,037).

Quatse et al. (Hereinafter Quatse) teaches customer information announcement method and system, comprising:

Independent Claims.

Claims 1 and 21-24. Maintaining database (list) of customers (column 1, lines 51-52); receiving dialed digits from a calling party corresponding to a phone number (column 3, lines 10-12); attempting to place a phone call connection from said calling party through the network to said phone number (column 3, lines 13-16); determining that said phone number is one of a changed phone number (column 3, lines 32-33); communicating with said calling party to offer additional information related to the telephone number entered (column 5, lines 10-12).

Quatse does not specifically teach that said additional information includes inquiry for determination whether said calling party may be interested in subscribing to any available additional phone number. Quatse also does not specifically teach that said offered to the calling party additional information is related to a called party profile.

Trell teaches a telephonic method and system, wherein a subscriber is offered an additional telephone number from a list of available, unused telephone numbers (column 1, lines 49-50; column 5, lines 45-49). Furthermore, Trell teaches that information provided to the customer is relevant to the previous information associated with the customer request (column 5, lines 58-60).

Kamel et al. (Hereinafter Kamel) teaches a communication method and system for delivering promotional messages, wherein said promotional messages are related to the subscriber's profile (column 1, line 63 – column 2, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Quatse to include determining whether said calling party may be interested in subscribing to any available additional phone number, as disclosed in Trell, because said subscription would advantageously generate additional revenue to telephone companies, as specifically stated in Trell (column 5, lines 44-50). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Quatse in view of Trell to include that said offered additional telephone number is related to the calling party profile, as disclosed in Kamel, because offering information related to the caller's profile would advantageously increase the possibility that said caller accepts said offer, thereby increase revenue.

Dependent Claims.

Claim 2. See reasoning applied to **claim 1**.

Claim 3. Quatse teaches: automatically communicating (pushing) to the subscriber (column 4, line 63 – column 5, line 14).

Claims 4-6. See reasoning applied to **claim 1**.

Claims 7-9. Trell teaches: generating said at least one second phone number (column 5, lines 44-50). The motivation to combine Quatse and Trell would be to generate additional revenue to telephone companies.

Claim 10. Trell teaches: generating said at least one second phone number (column 5, lines 44-50). The motivation to combine Quatse and Trell would be to generate additional revenue to telephone companies.

Information as to *the first phone number and said second phone number are one of a contiguous, same area code, same central exchange, and same block of 10, 100, 1,000 or 10,000 numbers* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Quatse in view of Trell and further in view of Kamel would be performed the same regardless of the type of the second phone number.

Claims 11-13. See reasoning applied to **claim 1**.

Claim 14. Trell teaches said method and system, wherein said calling party is one of a service provider, telephone operator, and directory assistance provider (column 2, lines 50-58).

Claim 15. See reasoning applied to **claim 1**.

Claim 16. Quatse teaches: receiving dialed digits entered by said calling party, said digits identifying a selected one of said options offered (column 5, lines 1-14).

Claim 17. Trell teaches: receiving speech from said calling party by operator (column 5, lines 58-59). The motivation to combine Quatse and Trell would be to generate additional revenue to telephone companies.

Claims 18-19. Trell teaches said method and system, wherein the subscriber initiates additional phone number request before said additional phone number is determined (column 2, lines 50-63). The motivation to combine

Quatse and Trell would be to generate additional revenue to telephone companies.

Claim 20. Quatse teaches: receiving a communication from the subscriber wherein said received communication is any communication other than that of a subscriber initiated request for subscribing to an available phone number (column 2, lines 8-9).

Claim 25. See reasoning applied to **claim 1**.

Response to Arguments

Applicant's arguments filed 06/28/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach *determining that at least one second phone number relating to said subscriber profile is available for subscription*, the examiner points out that offering additional information related to the telephone number entered in Quatse (column 5, lines 10-12) obviously indicates *determination of availability* of said information. As to *relating to said subscriber profile* feature, it is noted that Kamel was applied for this feature.

In response to the applicant's argument that the prior art does not teach a preamble, it is noted that the preamble comprises a general description of all the elements or steps which are conventional or known (MPEP 608.01 (i) (e).), and therefore, does not constitute an invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306


[Official communications; including After Final
communications labeled "Box AF"]

Art Unit: 3629

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

10/03/2004


DEANT. NGUYEN
PRIMARY EXAMINER 10/4/04